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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/697,570	10/26/2000	Shinya Matsuda	15162/02660	4859

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EXAMINER

CUEVAS, PEDRO J

ART UNIT

PAPER NUMBER

2834

DATE MAILED: 12/09/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/697,570	MATSUDA ET AL.
	Examiner	Art Unit
	Pedro J. Cuevas	2834

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 10 September 2002.

2a) This action is **FINAL**.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-12 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-12 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

1) Notice of References Cited (PTO-892)                    4) Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_ .

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)                    5) Notice of Informal Patent Application (PTO-152)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ .                    6) Other: \_\_\_\_\_ .

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,696,421 to Zumeris et al. in view of U.S. Patent No. 6,201,340B to Matsuda et al.

Zumeris et al. clearly teaches the construction of an actuator (40) for moving a driven member (42), said actuator comprising:

a displacement element (60) for producing a specific displacement;  
a drive member (64) connected to one end of said displacement element and which transfers the displacement of said displacement element to a driven member;  
a stationary member (62) which supports the other end of the displacement element; and  
a drive circuit for driving said displacement element, which is not shown but is inherent (see applied voltage waveforms in Figures 7A & 7B).

However, it fails to disclose an actuator having a compression member for pressing said driven member against the drive member such that the drive member and the driven member are in a state of intermittent contact, and under conditions near a condition of transition from the intermittent contact state to a normal contact state, and a second displacement element for producing a second specific displacement having a direction which has a predetermined angle to a direction of the first specific direction of said first displacement element.

Matsuda et al. teaches the construction of a compression member (20) for pressing said driven member against the drive member such that the drive member and the driven member are in a state of intermittent contact, and under conditions near a condition of transition from the intermittent contact state to a normal contact state, and a trust type actuator having two piezoelectric devices provided for crossing at right angle for the purpose of driving in a precise electronically controlled manner, a multiple axis rotational member or rotor by using a combination of predetermined elliptical trails.

It would have been obvious to one skilled in the art at the time the invention was made to use the trust type actuator disclosed by Matsuda et al. on the actuator disclosed by Zumeris et al. for the purpose of driving in a precise electronically controlled manner, a multiple axis rotational member or rotor by using a combination of predetermined elliptical trails instead of a common uncontrolled bearing assembly.

3. With regards to claims 2 and 8, Zumeris et al. discloses the claimed invention except for the relationship:

$$N_t = X_0 * ((1 / (1/k_2 + 1/k_3)) - (1 / (1/k_1 + 1/k_2 + 1/k_3)))$$

where  $k_1$  is the spring constant of the compression member,  $k_2$  is the combined spring constant of the displacement element and the drive member,  $k_3$  is the spring constant of the driven member,  $X_0$  is the amount of displacement of the displacement element, and  $N_t$  is the compression force applied by the compression member.

It would have been obvious to one skilled in the art at the time the invention was made to use the previously stated mathematical expression, which is nothing more than the standard formula to calculate the force of a spring, including the variables of the specific case at hand, for the purpose of determining the actual performance of the claimed invention.

4. With regards to claim 3, Zumeris et al. discloses that the actuator repeats it's periodic motion at high frequencies such as 20-150 KHz, as stated in lines 33-44 of column 4.

5. With regards to claim 4, Zumeris et al. discloses that the actuator repeats it's periodic motion at high frequencies such as 20-150 KHz, as stated in lines 33-44 of column 4.

6. With regards to claim 5 & 6, Matsuda et al. discloses an actuator wherein:

said displacement element is a laminate type piezoelectric element; and  
said displacement element includes alternating layers of a plurality of piezoelectric thin plates and electrodes,

as shown in Figure 1.

7. With regards to claims 9 and 10, Zumeris et al. discloses that the actuator repeats it's periodic motion at high frequencies such as 20-150 KHz, as stated in lines 33-44 of column 4.

8. With regards to claim 11 & 12, Matsuda et al. discloses an actuator, wherein said displacement element is a laminate type piezoelectric element and said displacement element includes alternating layers of a plurality of piezoelectric thin plates and electrodes as shown in Figure 1.

#### ***Response to Arguments***

9. Applicant's arguments filed September 10, 2002 have been fully considered but they are not persuasive.

10. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the

applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

11. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

#### ***Conclusion***

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO-892.

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pedro J. Cuevas whose telephone number is (703) 308-4904. The examiner can normally be reached on M-F from 8:30 - 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nestor R. Ramírez can be reached on (703) 308-1371. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-1341 for regular communications and (703) 305-3432 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

Pedro J. Cuevas  
December 2, 2002



NESTOR RAMIREZ  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2800